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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,989	04/16/2004	James Botelho	40699.0001	8730
7590	12/19/2005		EXAMINER KAMEN, NOAH P	
David L. Principe Hodgson Russ LLP Suite 2000 One M&T Plaza Buffalo, NY 14203-2391			ART UNIT 3747	PAPER NUMBER
DATE MAILED: 12/19/2005				

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/825,989
Filing Date: April 16, 2004
Appellant(s): BOTELHO ET AL.

David L. Principe
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 11/18/05 appealing from the Office action mailed 5/4/05.

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(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

4671216

Itoh

6-1987

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Itoh (4671216). Figures 3-5 show offset finned cylinders/blocks with DOHC including two intake and exhaust valves. The cylinders appear are arranged at 70 degrees. The crankcase is not disclosed as mounting to front and rear EVO mounts/drives.

While the cylinders are disclosed as being at 70 degrees, the figures actually show them to be around 45 degrees; it would have been obvious to one of ordinary skill in the art to arrange the cylinders at any angle desired for fitting within a motorcycle frame. The present specification admits (page 1) "many aftermarket engine manufacturers produce their designs based on this EVO mounting configuration"; therefore it would have been obvious to one of ordinary skill in the art to modify Itoh to fit onto stock EVO crankcase mounts/drives so as to reach a wide market.

(10) Response to Argument

The applicants argue 1) that the engine of Itoh could not fit into the stock EVO platform because the physical dimensions would not allow a front and rear motor mount to mate with the EVO engine mounting locations; and 2) the output is a driveshaft to the rear wheel which would not conform to the EVO drive train design. Modifying Itoh to fit would destroy the reference because the reference comprises an integral transmission with a drive shaft whereas the EVO engine uses a chain drive. 3) There is no teaching in Itoh to suggest modifying the engine to fit an EVO platform and that the background statement that aftermarket engines built to fit EVO platforms is insufficient. 4) While Itoh shows an angle of around 45 degrees between cylinders, the specification repeatedly discloses an angle of only 70 degrees.

The examiner contends that 1) there is nothing about the engine/transmission of Itoh that prevents the engine from being modified to fit an EVO platform; one of ordinary skill in the

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art could always modify the shape and size of the engine housing to fit into the motorcycle frame and receive bolts to be secured thereto. It is well settled that changes of shape and size are matters of design choice. 2) The engine of Itoh does indeed use a drive shaft (figure 7). The output uses a bevel gear. However, nowhere in the disclosure is the output shaft is it stated that an output shaft deemed critical. Indeed, there is no discussion at all. Both chain drives and drive shafts are well known and deemed obvious equivalents. Using a chain drive would not destroy Itoh. 3) The examiner contends that the background statement IS sufficient to suggest modifying any engine, subject to profitability. The background statement of widespread production of aftermarket engines for the EVO platform is proof of high demand. 4) The examiner agrees that Itoh contemplates 70 degrees as the best mode. However, there is no statement indicating the criticality of 70 degrees. Merely, that it is more compact than a 90-degree engine. Therefore, if one of ordinary skill in the art wanted an even more compact engine, one would make the angle even smaller, including 40-50 degrees. The 70 degree engine is merely shown "for purposes of example" (col.2, line 30-36).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Noah kamen



Noah P. Kamen
Primary Examiner

Conferees:

Mike Argenbright



Willis Wolfe



Henry Yuen

